

## REMARKS

Claims 1-4, 7-16, 18-28, 30 and 31 were examined in an Office Action mailed January 16, 2009 in the above case. Claim 19 is objected to for informalities. Claim 31 stands rejected under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph as indefinite. Claims 1-4, 7-11, 14, 16, 18 and 20-25 stand rejected as anticipated by *Shishkin* (U.S. Patent No. 4,764,237). Claims 28, 30 and 31 stand rejected as obvious over *Shishkin* in view of *Wood* (U.S. Patent No. 4,602,974). Claims 12, 13, 15 and 19 stand rejected as obvious over *Shishkin*, in view of *Graham* (WO 01/88338). Claim 26 stands rejected as obvious over *Shishkin* in view of *Kiest* (U.S. Patent No. 5,855,729). Claims 26 and 27 stand rejected as obvious over *Shishkin* in view of *Long, Jr.* (U.S. Patent No. 4,685,983).

Claims 1, 4, 8-11, 15, 19, 26 and 30 are amended, claims 28 and 31 are cancelled, and new claims 37-44 added herein, with no new matter added. Claims 1-4, 7-16, 18-27, 30 and 37-44 are pending. Further consideration is requested in view of the above amendments and the remarks which follow.

A. Objection to Claim 19 is Addressed.

The objection to claim 19 had been addressed by amending claim 19 to depend from claim 16, as examined in the Office Action. Withdrawal of the objection to claim 19 is requested.

B. Indefiniteness Rejection of Claim 31 is Addressed.

The 35 U.S.C. § 112, 2<sup>nd</sup> paragraph rejection of claim 31 is mooted by the cancellation of claim 31. Withdrawal of the rejection of claim 31 is requested.

Although elements of cancelled claim 31 are now incorporated into amended claims 1 and 30, the legal standard of 35 U.S.C. § 112, 2<sup>nd</sup> paragraph, as clearly articulated by the Court of Appeals for the Federal Circuit, does not require further amendments to claim 1 or claim 30 to include individual identification of the claimed "selected conditions" to be sensed and/or monitored. The Federal Circuit has held that whether a claim is invalid for indefiniteness depends on whether those skilled in the art would understand the scope of the claim when the claim is read in light of the specification. *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986). "If the claims

read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, § 112 demands no more.” *Miles Lab., Inc. v. Shandon, Inc.*, 997 F.2d 870, 875 (Fed. Cir. 1993).

In the present case, one skilled in the art would be able to apprise the scope of amended claims 1 and 30 read in light of the specification. For example, the Office is directed to page 25, line 22 to page 26, line 15 of the priority PCT Publication No. WO 2004/020893 for examples of such conditions which include the sensing and/or monitoring of (1) cleanliness of the inner surface of the conduit, (2) volumetric quantities and delivery rates for the resin, (3) temperature and humidity conductions during the lining process, and (4) strain and load applied on the everting liner. Since one skilled in the art would be able to apprise the scope of amended claims 1 and 30, amended claims 1 and 30 are in full compliance of 35 U.S.C. § 112, 2<sup>nd</sup> paragraph.

C. Anticipation Rejection of Claims 1-4, 7-11, 14, 16, 18 and 20-25 by *Shishkin* is Addressed.

The rejection of claims 1-4, 7-11, 14, 16, 18 and 20-25 under 35 U.S.C. § 102(b) as anticipated by *Shishkin* is respectfully traversed.

Independent claim 1 has been amended to clarify that the body of the apparatus (a) is located with in and moves along the inside of a conduit during installation of an everting flexible tube structure, (b) includes means for sensing and/or monitoring a plurality of selected conditions associated with installation of the flexible tube structure, and (c) includes means for varying installation as necessary in response to one or more of said plurality of selected conditions.

*Shishkin* fails to teach or suggest an apparatus which, during the lining process, includes a body located inside a conduit which incorporates means for monitoring the installation process, and means for varying conditions in the installation process in response to the sensing of the conditions. For these reasons alone, independent claim 1 and dependent claims 2-4, 7-11, 14, 16, 18 and 20-25 are patentably distinguish over *Shishkin*. Withdrawal of the anticipation rejection of claims 1-4, 7-11, 14, 16, 18 and 20-25 is thus proper and respectfully requested.

D. Obviousness Rejection of Claims 28, 30 and 31 by *Shishkin* in view of *Wood* is Addressed.

The rejection of claims 28 and 30 under 35 U.S.C. § 103(a) as obvious over *Shishkin* in view of *Wood* is respectfully traversed. The rejection is moot relative to cancelled claims 28 and 31.

Both *Shishkin* and *Wood* fail to teach or suggest a method which includes the steps of locating a body inside a conduit, which body incorporates means for monitoring the installation process, and means for varying conditions in the installation process in response to the sensing of the conditions, such that the related steps can be performed. Independent claim 30, as amended includes these features which are method steps analogous to the apparatus component elements of independent claim 1. For these reasons, independent claim 30, as amended, is patentably distinguish over *Shishkin* and *Wood*, either separately or in combination. Withdrawal of the obviousness rejection of claim 30 is respectfully requested.

E. Obviousness Rejection of Claims 12, 13, 15 and 19 by *Shishkin* in view of *Graham* is Addressed.

The rejection of claims 12, 13, 15 and 19 under 35 U.S.C. § 103(a) as obvious over *Shishkin* in view of *Graham* is respectfully traversed.

*Graham* also fails to teach or suggest a body of an apparatus which, during the lining process, is located inside a conduit and incorporates means for monitoring the installation process and means for varying conditions in the installation process in response to the sensing of the conditions. Since claims 12, 13, 15 and 19 incorporate these features through direct or indirect dependency from claim 1, claims 12, 13, 15 and 19 are patentably distinguishable over the combination of *Shishkin* in view of *Graham*. Withdrawal of the obviousness rejection of claims 12, 13, 15 and 19 is proper and respectfully requested.

F. Obviousness Rejection of Claim 26 by *Shishkin* in view of *Kiest* is Addressed.

Claim 26 stands rejected under 35 U.S.C. § 103(a) as obvious over *Shishkin* in view of *Kiest*. This rejection is respectfully traversed.

*Kiest* also fails to teach or suggest a body of an apparatus which, during the lining process, is located inside a conduit, and incorporates means for monitoring the installation process and means for varying conditions in the installation process in response to the sensing of the conditions. Since claim 26 incorporates these features through indirect dependency from claim 1, claim 26 is patentably distinguishable over a combination of *Shishkin* and *Kiest*.

Withdrawal of the obviousness rejection of claims 26 is respectfully requested.

G. Obviousness Rejection of Claim 26 and 27 by *Shishkin* in view of *Long, Jr.* is Addressed.

The rejection of claims 26 and 27 under 35 U.S.C. § 103(a) as obvious over *Shishkin* in view of *Long* is respectfully traversed.

*Long* also fails to teach or suggest a body of an apparatus which, during the lining process, is located inside a conduit, and incorporates means for monitoring the installation process and means for varying conditions in the installation process in response to the sensing of the conditions. Since claims 26 and 27 incorporate these features through indirect dependency from claim 1, claims 26 and 27 are patentably distinguishable over the combination of *Shishkin* in view of *Long*. Withdrawal of the obviousness rejection of claims 26 and 27 is proper and respectfully requested.

H. Substitute Declaration

Enclosed is a Substitute Declaration which corrects the spelling of the inventor's first name.

I. Conclusion and Petition for 2-Month Extension

Claims 1-4, 7-16, 18-27, 30 and 37-44 being in form for allowance, such action is respectfully requested. Should any issues remain, the Examiner is kindly asked to telephone the undersigned.

The undersigned hereby petitions for a 2-month extension. Please charge Deposit Account No. 50-1123 the 2-month extension fee.

Fees were previously paid for 3 independent claims and 27 total claims. Two independent claims and 33 total claims are now pending. Please charge

Deposit Account No 50-1123 for 6 additional excess total claims and for any other fees associated with this filing.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'Carol W. Burton', is written over a horizontal line.

Carol W. Burton, Reg. No. 35,465  
Hogan & Hartson L.L.P.  
1200 17<sup>th</sup> Street, Suite 1500  
Denver, CO 80202  
Telephone: (303) 454-2454  
Facsimile: (303) 899-7333